

REMARKS

At the time of the Non-Final Office Action dated November 21, 2008, claims 1-10 were pending in this application. Claims 1-10 were rejected and claims 2, 4, and 8 were objected to because of informalities. Claims 11-30 were previously canceled. Claims 31-50 have been added and are substantially identical to the previously canceled claims 11-30.

CLAIMS 1, 9 AND 17 ARE OBJECTED TO BECAUSE OF INFORMALITIES

On page 8, paragraph 4 of the Non-Final Office Action, the Examiner asserted, “claim 1 recites ‘user information and course information’ in lines 1-2 which is not the same as ‘the user and course information’ in line 4 ... appropriate correction is required.” Although Applicants believe that there is no ambiguity, the Applicants have amended claims 1, 9 and 17 to include the phrase “user information and course information” as the Examiner has suggested. Accordingly, these amendments are not related to patentability

CLAIMS 1, 4-5, 7-8, 17, 20-21 AND 23-24 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 8-9, paragraph 5 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 1, 4-5, 7-8, 17, 20-21, 23-24, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

Claim 1

Independent claim 1 is directed to a “method of transforming user information and course information from a source database in an e-learning model to a target database in a learning management system.” (emphasis added). 35 U.S.C. § 101 states that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Within In re Bilski, Appeal No. 2007-1130 (Fed. Cir. 2008), the Federal Circuit “[clarified] the standards applicable in determining whether a claimed method constitutes a statutory ‘process’ under § 101.” The Federal Circuit framed the issue as to whether a claimed method constitutes a statutory process as follows:

The true issue before us then is whether Applicants are seeking to claim a fundamental principle (such as an abstract idea) or a mental process. And the underlying legal question thus presented is what test or set of criteria governs the determination by the Patent and Trademark Office (“PTO”) or courts as to whether a claim to a process is patentable under § 101 or, conversely, is drawn to unpatentable subject matter because it claims only a fundamental principle.

At the outset, Applicants note that the Examiner has neither alleged nor provided any substantial evidence to support a finding that claim 1 attempts to claim either a

fundamental principle or a mental process. Therefore, the Examiner's has failed to set forth a prima facie case under 35 U.S.C. § 101.

On page 8, paragraph 5 of the Non-Final Office Action, the Examiner asserts "The transformation as recited in claim 1 does not transform the underlying subject matter (such as an article or materials) to a different state or thing. Therefore, claim 1 does not produce concrete, useful and tangible result." Applicants respectfully disagree with this assertion. Claim 1 is clearly not a mental process since the conversion of user information and course information to a format compatible with a target database is not a mental process. The only other issue that need be addressed is whether or not "[Applicants'] claim recites a fundamental principle and, if so, whether it would pre-empt substantially all uses of that fundamental principle if allowed." Biliski at __. The Examiner has not alleged that claim 1 is directed to a fundamental principle or even characterized what that "fundamental principle" might be. Thus, there is no need to determine if claim 1 preempts substantially all uses of the (unidentified) fundamental principle.

However, should the Examiner put forth substantial evidence to establish that claim 1 recites a fundamental principle, the Federal Circuit within In re Bilski looked to the following test to determine whether a process claim is narrowly tailored so as to not preempt all uses of the fundamental principle:

A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Thus, the machine-or-transformation test is a two-branched inquiry – a method claim satisfies 35 U.S.C. § 101 by being tied to a particular machine or transforming an article. Gottschalk v. Benson, 409 U.S. 63, 70 (1972).

Turning to the second branch, claim 1 transforms a particular article into a different state or thing. As recited in claim 1, transforming user information and course information from a source database in an e-learning model to a target database in a learning management system is created. The act of the creation is a transformation, and the source database and the target database are the article. Therefore, claim 1 is directed to statutory subject matter under 35 U.S.C. § 101 since claim 1 transform a particular article into a different state or thing.

Claim 17

Independent claim 17 has been amended to clarify that the claim is directed to a data transformation tool of a computer system. Figure 1 of Applicants' disclosure clearly illustrates that the claimed invention is embodied in hardware. Reference is also made to paragraph [0031], lines 4-12 of Applicants' disclosure. Applicants respectfully submit that claim 17 (and those claims dependent upon claim 17) are directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

THE REJECTION OF CLAIMS 1, 4-5, 9, 12-13, 17 AND 20-21 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON U.S. PATENT NO. 6,016,501 TO MARTIN, ET AL., (HEREINAFTER MARTIN) IN VIEW OF U.S. PATENT NO. 6,985,905 B2 TO PROMPT, ET AL., (HEREINAFTER PROMPT) AND IN FURTHER VIEW OF U.S. PATENT NO. 6,978,115 B2 TO WHITEHURST, ET AL., (HEREINAFTER WHITEHURST)

On pages 10-12, of the Non-Final Office Action, the Examiner concluded that one of ordinary skill in the art would have been impelled to modify Martin in view of Prompt in further view of Whitehurst to arrive at the claimed invention. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon viewing the Examiner's analysis with the First Office Action, the Examiner has failed to identify any of the above-described rationales. If the Examiner is to maintain the present rejection, Applicants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

For example, as discussed on page 57,534 of the Examination Guidelines, if the Examiner is to rely upon rationale (G), the following findings of fact must be articulated by the Examiner:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background

for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

The Examiner, however, has failed to perform much of this analysis. As such, the Examiner has not even established a prima facie case of obviousness.

At page 4, the last full paragraph of the Office Action, the Examiner asserts: Examiner provided Martin which discloses a data transformation from a source database to a target database. The data such as "learning process" or "LMS" or "user information" or "course information" or an (e-learning model" are just data which were disclosed by Martin.

The failure of the Examiner to consider the limitations of “learning process”, “learning management system”, “LMS”, “user information”, “course information” and “e-learning model” is clear reversible error. First, as is known to one of reasonable skill in the art, a “learning management system” (LMS) is an application or Web-based technology used to plan, implement, and assess a specific learning process. Typically, a learning management system provides an instructor with a way to create and deliver content, monitor student participation, and assesses student performance. A learning management system may also provide students with the ability to use interactive features such as threaded discussions, video conferencing, and discussion forums. Thus, the Examiner has erroneously identified the “learning management system” or “LMS” as “just data”.

Similarly, as is known to one of reasonable skill in the art, e-learning models are attempts to develop frameworks to address the concerns of the learner and the challenges presented by the technology so that online learning can take place effectively. New e-learning models are continually emerging as new research findings in the area of e-learning become available. Thus, the Examiner has erroneously identified the “e-learning models” as “just data”.

Accordingly, the Examiner has failed to designate the teachings in Martin, Prompt and Whitehurst being relied upon to state the rejection. In this regard, the Examiner’s rejection under 35 U.S.C. § 103 fails to comply with 37 C.F.R. § 1.104(C). Thus, Martin, Prompt and Whitehurst fail as references to sufficiently establish a *prima facie* case of obviousness.

**THE REJECTION OF CLAIMS 8, 15 and 23 UNDER 35 U.S.C § 103 FOR
OBVIOUSNESS BASED UPON MARTIN IN VIEW OF PROMPT AND IN VIEW OF
WHITEHURST AND FURTHER IN VIEW OF HAIMOWITZ**

Claims 8, 15 and 23 all recite the additional feature of “if more than one potential match is found creating a file containing the potential matches and re-generating the matching process.” Haimowitz cannot correct the deficiencies of the Martin, Prompt and Whitehurst references and therefore the Examiner’s rejection under 35 U.S.C. § 103 fails to comply with 37 C.F.R. § 1.104(C). Thus, Martin, Prompt, Whitehurst and Haimowitz fail as references to sufficiently establish a prima facie case of obviousness.

**THE REJECTION OF CLAIMS 7, 16 and 24 UNDER 35 U.S.C § 103(A) FOR
OBVIOUSNESS BASED UPON MARTIN IN VIEW OF PROMPT AND IN VIEW OF
WHITEHURST AND FURTHER IN VIEW OF DOYLE**

Claims 7, 16 and 24 all recite the additional feature of “wherein storing unmatched object identifiers for manual handling comprises further creating a file containing the unmatched object identifiers having a format similar to the converted user information and course information.” Doyle discloses a system and method employing computer speech recognition of users' vocal tag utterances to create a catalog of the contents of user-recorded audio-video media such as VCR tapes. A vocal tag is spoken into a

microphone, associated with each recorded program and stored in a database of tape contents within a VCR.

Notably, Doyle fails to teach or even mention a “learning progress” or “LMS” or “user information” or “course information” for an “e-learning model”. Accordingly, Doyle cannot correct the deficiencies of the Martin, Prompt and Whitehurst references and therefore the Examiner’s rejection under 35 U.S.C. § 103 fails to comply with 37 C.F.R. § 1.104(C). Thus, as it will be clear to the Honorable Board, Martin, Prompt, Whitehurst and Doyle fail as references to sufficiently establish a prima facie case of obviousness.

Applicants have made every effort to present claims, which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Respectfully submitted,

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